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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/304,379 | 05/04/1999 | MICHAEL JOSEPH GARDNER | 1152 | 9580 |
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EXAMINER

NGO, RICKY QUOC

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/304,379

Applicant(s)

GARDNER ET AL.

Examiner

Ricky Ngo

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Information Disclosure Statement

1. The references cited in pages 12 and 45 in the specification are not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-104 of U.S. Patent No. 6,314,103. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 35, 69, 75 of the instant application merely broadens the scope of the claims 1, 17, 33, 43, 53, 65, 73, 87, 96, and 100 of the parent patent by eliminating the elements and their functions of the claims. It has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Claim Rejections - 35 USC § 112

4. Claims 14, 17, 20, 32, 48, 51, 54, 70, & 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claims 14 & 48, the limitation "the data call comprises a clear channel call" is not clear what the "clear channel call" is.
- In claims 17 & 51, it is not clear what it means "an automatic number identifier".
- In claims 20, 54, 70, & 76, it is not clear what "a call trigger" is.
- Claim 32 is improperly indicated as being dependent upon itself.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-80 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Medhat et al., US Patent No. 6,314,103. The specification clearly shows support for all the claimed limitations. No further explanation is necessary.

7. Claims 1-21, 27-31, 33-55, and 61-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Charvillat, US Patent No. 5,315,586.

- Charvillar discloses a system and method for reallocating network resource, e.g. bandwidth, in responsive to a connection request from a user. See abstract. It is found that the system elements and their associated functions substantially correlate the limitations that are broadly recited in the claims. It's also noted that the usage of some words in the reference is not identical as used in the claims, however, it is not required to be anticipatory. In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990). For evidence, a comparison of the claimed limitations and the subject matter taught by Charvillat is briefly identified hereafter:

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- Regarding claim 1, a signaling processor (controller 102 of Fig. 1) receives the call signaling (e.g. user connection request) to determine an allocated bandwidth for the user communications, and to transmit a control message identifying the allocated bandwidth (see col. 4 lines 15-34); and a connection system (UPC 105) receives the user communications and the control message, and connects the user communications according to the allocated bandwidth identified in the control message (see paragraph bridging cols. 3 and 4).

- Regarding claims 2-7, the signaling processor being adapted to determine an encoding/decoding scheme with encryption/decryption and compression/decompression for the user communications is inherently taught by Charvillat.

- Regarding claim 8, the signaling processor being adapted to determine the allocated bandwidth based upon a control feature (see Fig. 7).

- Regarding claim 9, the control feature comprises a call admission control method (Fig. 7).

- Regarding claim 10, the control feature comprises quality of service (inherently provided in ATM).

- Regarding claim 11-21, the control feature comprises a type of call such as a voice call, a data call, a clear channel call, a facsimile call, a subscriber profile, an automatic number identifier, or an accounting package for the call. These types of calls are inherently supported by Charvillat's system because it is a ATM system.

Regarding claims 27-29, the signaling processor is adapted to select a connection and to designate the selected connection in the control message; and the connection system comprises an interworking unit adapted to receive the user communications, to receive the control message,

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and to interwork the user communications over the connection designated by the signaling processor according to the allocated bandwidth (e.g. providing an user connection over the switch fabric 101 or other network nodes as shown in Fig. 1).

- Regarding claim 30 & 33 the signaling processor further is adapted to transmit new call signaling (col. 6, lines 55-59).

- Regarding claim 31, the system further comprises a communication device adapted to receive the new call signaling (e.g. other network nodes).

- Regarding claim 34, the communication device comprises a switch (e.g. switch fabric).

- A further review of the limitations of claims 35-55, and 61-80 reveals that they closely parallel the limitations addressed in connection with the earlier claims. For sake of brevity, it is believed that the reasons for rejecting the limitations of the earlier claims apply to these.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 22-26 and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charvillat, US Patent No. 5,315,586 in view of Sibbitt et al, 5,065,393.

- Charvillat discloses all the limitations of the claimed invention as set forth above, except an accounting system determining a rate for a type of call over the network. It was well-known in the art that the accounting system is for billing purpose which reflects the user actual

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usage of the network resource. Sibbitt et al. teach such billing technique in a system as described in col. 3 lines 39-49. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the billing system of Sibbitt et al. in the system of Charvillar for providing billing dependent upon the user usage of the network resources.

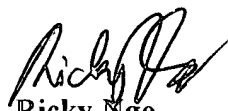
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky Q. Ngo whose telephone number is 703-305-4798. The examiner can normally be reached on MaxFlex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Ricky Ngo
Primary Examiner
Art Unit 2664

April 20, 2002